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| APPLICATION NO. |] 1 | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. | |
|-----------------|-----------------------|-----------------------|-----------------------|-------------------------|------------------|--|
| 09/883,797 | 09/883,797 06/18/2001 | | Jan G. Jaworski | 07148-064002 | 3128 | |
| 26191 | 7590 | 03/01/2005 | | EXAMINER | | |
| FISH & RI | | SON P.C. HER PLAZA | MCELWAIN, ELIZABETH F | | | |
| 60 SOUTH | | | ART UNIT | PAPER NUMBER | | |
| MINNEAPO | DLIS, MI | N 55402 | 1638 | | | |
| | | | | DATE MAILED: 03/01/2005 | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | Application No. | Applicant(s) | | | | |
|--|---|--|---|--|--|--|--|
| | Office Action Summan. | 09/883,797 | JAWORSKI ET AL. | | | | |
| | Office Action Summary | Examiner | Art Unit | | | | |
| | | Elizabeth F. McElwain | 1638 | | | | |
| The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply | | | | | | | |
| THE - Exte after - If the - If NC - Failu Any | ORTENED STATUTORY PERIOD FOR REPLY MAILING DATE OF THIS COMMUNICATION. nsions of time may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. period for reply specified above is less than thirty (30) days, a reply period for reply is specified above, the maximum statutory period were to reply within the set or extended period for reply will, by statute, reply received by the Office later than three months after the mailing ed patent term adjustment. See 37 CFR 1.704(b). | 6(a). In no event, however, may a reply be tim within the statutory minimum of thirty (30) days ill apply and will expire SIX (6) MONTHS from to | ely filed s will be considered timely. the mailing date of this communication. O (35 U.S.C. § 133). | | | | |
| Status | | | | | | | |
| 1) 🗌 | Responsive to communication(s) filed on | | | | | | |
| | · · · · · · · · · · · · · · · · · · · | - action is non-final. | • | | | | |
| 3) 🗌 | 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is | | | | | | |
| | closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. | | | | | | |
| Dispositi | ion of Claims | · | | | | | |
| 4) 🛛 | 4)⊠ Claim(s) <u>33-37 and 40-51</u> is/are pending in the application. | | | | | | |
| | 4a) Of the above claim(s) is/are withdrawn from consideration. | | | | | | |
| | 5) ☐ Claim(s) is/are allowed. 6) ☑ Claim(s) <u>33-37 and 40-51</u> is/are rejected. 7) ☐ Claim(s) is/are objected to. | | | | | | |
| 6)⊠ | | | | | | | |
| 7) | | | | | | | |
| 8)□ | Claim(s) are subject to restriction and/or | election requirement. | | | | | |
| Applicati | on Papers | | | | | | |
| 9) The specification is objected to by the Examiner. | | | | | | | |
| 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner. | | | | | | | |
| Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). | | | | | | | |
| Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). | | | | | | | |
| 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. | | | | | | | |
| Priority u | ınder 35 U.S.C. § 119 | | | | | | |
| 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). | | | | | | | |
| | a) ☐ All b) ☐ Some * c) ☐ None of: | | | | | | |
| | 1. Certified copies of the priority documents have been received. | | | | | | |
| 2. Certified copies of the priority documents have been received in Application No | | | | | | | |
| | 3. Copies of the certified copies of the priority documents have been received in this National Stage | | | | | | |
| | application from the International Bureau | | | | | | |
| * See the attached detailed Office action for a list of the certified copies not received. | | | | | | | |
| | | | | | | | |
| Attachment | • • | _ | | | | | |
| | e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO-948) | 4) | PTO-413) | | | | |
| 3) 🔲 Inforn | nation Disclosure Statement(s) (PTO-1449 or PTO/SB/08) No(s)/Mail Date | 5) Notice of Informal Pa 6) Other: | | | | | |

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DETAILED ACTION

Response to Amendment

Claims 1-32, 38 and 39 have been cancelled previously.

No claims have been amended.

Claims 33-37 and 40-51 are pending and are examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

- 1. Claims 33-37 and 40-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim8-20, 44, 51 and 58 of U.S. Patent No. 6,307,128 for the reasons stated in the last office action.
- 2. The terminal disclaimer filed on June 7, 2004 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of U.S. Patent 6,307,128 has been reviewed and is NOT accepted.

The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

It is directed to a particular claim or claims, which is not acceptable, since "the disclaimer must be of a terminal portion of the term of the entire [patent or] patent to be granted." See MPEP § 1490.

In addition, applicants state in the response filed December 1, 2004 that the assignee information is incorrect.

The submission of a terminal disclaimer that complies with the requirements will overcome the rejection.

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3. Applicants' arguments filed December 1, 2004 have been fully considered but they are not persuasive. Applicants argue that the present application is a divisional of U.S. Patent 6,307,128, which was restricted during prosecution on August 28, 1998, and Group I was elected. Applicants assert that the present application is drawn to Group II of the parent application, but that the claims of the present case were restricted. Applicants elected and prosecuted the claims of Group VIII. Therefore, applicants assert that due to the restriction requirements, no Terminal Disclaimer is required.

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4. The Examiner maintains that the present claims are drawn to what would be considered the same Group that was elected and prosecuted in the parent application, which is now U.S. Patent 6,307,128. The parent application was restricted into two Groups. Group I, drawn to the claimed gene, plant cells and plants transformed with the gene, which was elected. Group II, drawn to the polypeptide, which was not elected. The present claims are **not** drawn to the nonelected group of the parent application. The present claims are **not** drawn to a polypeptide. The present claims are drawn to an invention that is made obvious by the already patented claims. Therefore, a proper Terminal Disclaimer is still required.

No claims are allowed.

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until

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after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (571) 272-0802. The examiner can normally be reached on increased flex time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Elizabeth F. McElwain, Ph.D.

Primary Examiner

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